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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,479	01/15/2004	Gerhard Gumpoltsberger	ZAHFRI P596US	5982

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EXAMINER
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LEWIS, TISHA D

ART UNIT	PAPER NUMBER
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3681

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/758,479

Applicant(s)

GUMPOLTSBERGER, GERHARD

Examiner

TISHA D. LEWIS

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26 and 29-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

The following is a first action on the merits of application serial no. 10/758,479 filed on January 15, 2004.

#### ***Election/Restrictions***

Claim 27 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 29, 2005.

#### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Information Disclosure Statement***

The information disclosure statement filed January 15, 2004 has been considered.

#### ***Claim Objections***

Claims 29-50 are objected to because of the following informalities:

-Claims 29-50 should be re-numbered as claims 28-49. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 39 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitations in claim 39 are indefinite due to a reference in the body of the claim directed to a cancelled claim 13.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 26, 29, 32, 33, 35, 37-39, 42 and 47-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Nielsen ('435). Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Nielsen discloses a multiple speed transmission having a drive input (28), a drive output (84), a housing (70), three planetary gear sets (32, 34, 36), six rotating shafts, five shift elements (64, 66, 68, 72, 74) of clutches and brakes engaging in combinations of two (Figure 2) to provide six forward and one reverse speed, the input is connected directly to a sun gear (38) of the first gear set, an ring gear (40) is fixed to the housing (70), the output takes place via a second shaft connected to an a ring gear (48) of the

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second gear set and to a carrier (58) of the third gear set, a third shaft is permanently connected to a carrier (50) of the second gear set and to a ring gear (56) of the third gear set, a fourth shaft is permanently connected to a sun gear (46) of the second gear set, a fifth shaft is permanently connected to a carrier (42) of the first gear set and a sixth shaft is permanently connected to a sun gear (54) of the third gear set wherein the third shaft can be coupled to the housing by a first brake (74), the fourth shaft can be coupled to the housing by a second brake (72), a first clutch (66) connects the input to the third shaft, a second clutch (64) connects the input to the sixth shaft and a third clutch (68) connects the fourth and fifth shafts, freewheels (78) are connected to shafts in the transmission, the drive input and output are provided on opposite sides of the housing, a torque converter (10) is used as an external element to start the engine and connect it to the input drive, a torsional damper (26) is arranged between the engine and transmission and the clutches and brakes have disk arrangements for form enclosing.

Claims 26, 29, 35-39 and 47-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Uoro et al ('752). Uoro et al discloses a multiple speed transmission having a drive input (17), a drive output (19), a housing (60), three planetary gear sets (430, 440, 420), six rotating shafts, five shift elements (450, 452, 454, 456, 458) of clutches and brakes engaging in combinations of two (Figure 10) to provide six forward and one reverse speed, the input is connected directly to a sun gear (442) of the first gear set, an ring gear (444) is fixed to the housing (60), the output takes place via a second shaft (472) connected to an a ring gear (434) of the second gear set and to a

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carrier (429) of the third gear set, a third shaft (470) is permanently connected to a carrier (436) of the second gear set and to a ring gear (424) of the third gear set, a fourth shaft is permanently connected to a sun gear (432) of the second gear set, a fifth shaft is permanently connected to a carrier (449) of the first gear set and a sixth shaft is permanently connected to a sun gear (422) of the third gear set wherein the third shaft can be coupled to the housing by a first brake (456), the fourth shaft can be coupled to the housing by a second brake (458), a first clutch (450) connects the input to the third shaft, a second clutch (452) connects the input to the sixth shaft and a third clutch (454) connects the fourth and fifth shafts, the drive input and output are provided on opposite sides of the housing, a final drive (16) is arranged on an output side of the housing, a torque converter (TC) is used as an external element to start the engine and connect it to the input drive, and the clutches and brakes have disk arrangements for form enclosing.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen and Usoro et al in view of Raghavan et al ('967). Nielsen and Usoro et al discloses an ring gear fixed to a housing, but not using a brake.

Raghavan et al discloses a transmission wherein a brake (54) is used to fix a ring gear (24) to a housing (60).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide a brake between the ring gear and housing in view of Raghavan et al to provide selective connection to the housing which would obtain a different ratio speed between the gears.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen and Usoro et al in view of Raghavan et al as applied to claims 26 and 30 above, and further in view of Schmidt ('757). Nielsen and Usoro et al in view of Raghavan et al discloses a transmission, but not with an electric machine.

Schmidt discloses a transmission having three planetary gear sets controlled by an electric machine (56 or 72).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide Nielsen and Usoro et al in view of Raghavan et al with an electric machine in view of Schmidt to provide additional torque to drive or brake the output to the wheels.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen and Usoro et al in view of Miyazaki et al ('178). Nielsen and Usoro et al disclose input and output drives, but not on the same side.

Miyazaki et al discloses a transmission having three planetary gear sets and an input (22) and output (24) disclosed on the same side of a housing (26).

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide the input and output of Nielsen and Usoro et al on the same side in view of Miyazaki et al to reduce the axial length of the transmission.

Claims 40, 41, 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen and Usoro et al in view of Sato et al ('292).

As to claims 40 and 41, Nielsen and Usoro et al disclose an engine connected to a transmission, but not permanently.

Sato et al discloses a transmission having an engine (2) connected permanently to a drive input (3) and started by at least one of the shift elements.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide a permanent connection between the engine and transmission of Nielsen and Usoro et al in view of Sato et al to reduce the number of components in the powertrain which reduces cost.

As to claims 43 and 44, Nielsen and Usoro et al disclose brakes on the rotating shafts, but not on the drive input or drive output.

Sato et al discloses a brake (29) connected to the drive output (21).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide a brake on the drive input or output of Nielsen or Usoro et al in view of Sato et al to selectively absorb a portion of the rotational energy of the output shaft.



Claims 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen and Usoro et al in view of Schmidt ('757). Nielsen and Usoro et al discloses a transmission, but does not disclose if an auxiliary can be driven.

Schmidt discloses a transmission having three planetary gear sets wherein an auxiliary drive output (via 86) is arranged on an input shaft (12) of the transmission.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide Nielsen and Usoro et al with an auxiliary drive output in view of Schmidt to provide torque to another device while driving the vehicle wheels.

Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen and Usoro et al in view of Schmidt ('757). Nielsen and Usoro et al discloses a transmission, but not with an electric machine.

Schmidt discloses a transmission having three planetary gear sets controlled by an electric machine (56 or 72).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide Nielsen and Usoro et al with an electric machine in view of Schmidt to provide additional torque to drive or brake the output to the wheels.

### **FACSIMILE TRANSMISSION**

Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is **(703) 872-9326 before final and 703-872-9327 after final**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be

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Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

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\_\_\_\_\_  
(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Raghavan et al ('988), Nielsen ('408), Polak ('927) and Ziemer ('831).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TISHA D. LEWIS whose telephone number is 571-272-7093. The examiner can normally be reached on M-Thur 6 AM TO 2:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHARLES A. MARMOR can be reached on 571-272-7095. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tdl  
September 19, 2005

  
TISHA LEWIS  
PRIMARY EXAMINER  
AU 3681 9/19/05